

REMARKS

I. Status of the Claims

These Remarks are made in response to the Office Action of October 27, 2010 ("Office Action"). Claims 1-4, 6, 7, 9-19, 21, 22, 24-34, 36, 37, and 39-45 are pending in this application, of which claims 1, 16, and 31 are independent. By this Amendment, Applicants have amended claims 1, 16, and 31.

In the Office Action, the Examiner took the following actions:

- (i) rejected claims 1-4, 6-7, and 9-15 under 35 U.S.C. § 101, as allegedly directed to non-statutory subject matter;
- (ii) rejected claims 1-7, 12-22, 27-37, and 42-45 under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 5,901,214 ("*Shaffer*"), in view of U.S. Patent Pub. No. 2004/0211834 ("*Fleckenstein*"), and further in view of U.S. Patent Pub. No. 2006/0031213 ("*Wilson*"); and
- (iii) indicated claims 9-11, 24-26, and 39-41 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, but objected to those claims as being dependent upon a rejected base claim.

Applicants thank the Examiner for indicating that claims 9-11, 24-26, and 39-41 would be allowable if rewritten in independent form. Nevertheless, Applicants respectfully traverse the rejections and objections as follows.

II. Rejections Under 35 U.S.C. § 101

Claims 1-4, 6-7, and 9-15 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In particular, the Office Action states that

the method steps are not tied to a particular machine or apparatus. Office Action at 3. Applicants respectfully disagree, and assert that at least the claimed “processor” performs various steps recited in claim 1.

However, to advance prosecution, Applicants have amended claim 1 to recite “affixing the alternate delivery point code onto a mail item for use in a sequenced delivery.” Clearly, this is a physical transformation, rendering the 35 U.S.C. § 101 rejections moot. Consequently, the Examiner should withdraw the 35 U.S.C. § 101 rejections.

III. Rejections Under 35 U.S.C. § 103(a)

Applicants also respectfully traverse the § 103(a) rejections. The Office Action does not establish a *prima facie* case of obvious with regard to claims 1-4, 6, 7, 9-19, 21, 22, 24-34, 36, 37, and 39-45.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the Office Action does not properly determine the scope and content of the prior art or ascertain the differences between the claims and the prior art. Accordingly, it does not clearly articulate a reason why the prior art would have rendered the claims obvious to one of ordinary skill in the art.

For example, amended independent claims 1 recites, among other things, **"the alternate delivery point code contains the same number of digits as the normal delivery point code, wherein the alternate delivery point code distinguishes the particular location from a plurality of locations at the delivery point and is used to sequence delivery to the particular location among the plurality of locations at the delivery point."** Amended independent claims 16 and 31 recite similar subject matter. This amendment is supported throughout the specification, as is apparent, for example, at ¶¶ [0062] and [0063] and Figures 1, 2, and 4.

The cited references do not teach or suggest at least this subject matter. The Examiner has correctly acknowledged that *Shaffer* and *Wilson* do not teach similar subject matter. See Office Action at 6-7. Instead, the Examiner cites *Fleckenstein* for

the alternate delivery point code subject matter. See Office Action at 6-7. However, *Fleckenstein* is deficient for at least two reasons.

A. The “alternate delivery code” disclosed in *Fleckenstein* does not constitute or suggest an “alternate delivery point code,” as claimed by Applicants.

The “alternate delivery code” of *Fleckenstein* does not constitute or suggest the claimed “alternative delivery point code,” because Applicants’ amended claim 1 explicitly recites that “the alternate delivery point code [1] distinguishes the particular location from a plurality of locations at the delivery point and [2] is used to sequence delivery to the particular location among the plurality of locations at the delivery point.” Amended independent claims 16 and 31 recite similar subject matter. The alternate delivery code disclosed in *Fleckenstein* does not meet either criteria. More specifically, rather than distinguishing “the particular location from a plurality of locations at the delivery point,” as claimed, the alternate delivery code disclosed in *Fleckenstein* instead specifies a completely different delivery point that is used when the recipient is unavailable at the first delivery point. *Fleckenstein* at ¶¶ [0005], [0014].

The alternate delivery code in *Fleckenstein* also is not “used to sequence delivery to the particular location among the plurality of locations at the delivery point,” as claimed. Instead, *Fleckenstein*’s code serves a completely different purpose of redirecting a mail item when the recipient is not home, effectively causing a delivery that is not in sequence whatsoever. *Fleckenstein* at ¶ [0013].

Further, the alternate delivery code in *Fleckenstein* is not affixed “onto a mail item for use in sequencing delivery of the mail item,” as recited in claim 1 and similarly recited in claims 16 and 31. Instead, the Examiner acknowledges that the disclosed

alternate delivery code in *Fleckenstein* is not placed on mail items but, is merely associated with a item-specific code through use of a database. Office Action at 18. Moreover, *Fleckenstein*'s alternate delivery code is only retrieved from the database upon a delivery failure to the primary address.

Consequently, for at least these reasons, *Fleckenstein* does not teach or suggest the above-claimed subject matter. The other cited references do not cure the shortcomings of *Fleckenstein*.

- B. The "item code" in *Fleckenstein* does not constitute or suggest a "normal delivery point code," as claimed by Applicants, and therefore is not suggestive of an alternate delivery point code "containing the same number of digits as the normal delivery point code."**

In addition to the above shortcomings, *Fleckenstein* also does not disclose or suggest an alternate delivery point code "containing the same number of digits as the normal delivery point code," as claimed. The Examiner's contrary assertion is based upon the fact that *Fleckenstein*'s item code (which is specific to an item, not a delivery location) does not change when the item is delivered to an alternate location.

Applicants respectfully disagree with the Examiner's interpretation of *Fleckenstein*, at least because the item code in *Fleckenstein* is not a "normal delivery point code," as claimed by Applicants, and therefore cannot be the basis of suggesting an alternate delivery point code "containing the same number of digits as the normal delivery point code." Applicants' amended claims 1, 16, and 31 explicitly recite that the "normal delivery point code is used to sequence delivery to a location among different delivery locations," rendering the Examiner's argument on page 18-19 of the Office Action moot. In contrast to the recitations of the amended claims, the item code

disclosed in *Fleckenstein* does not pertain to the delivery location whatsoever, and instead appears to be assigned to each delivered item as a way to track the delivery of the item. This is presumably why the item code is read after delivery to the first location, and before sending it on to the alternate location specified by the alternate delivery code. *Fleckenstein* at ¶ [0015]. (This is also the reason why the item code does not change even when routed to a different location – because it is still the same item.) Clearly, since the item code is not read before delivery, it cannot possibly be used to “sequence delivery to a location among different delivery locations,” as claimed by Applicants, and, consequently, is not analogous to the claimed “normal delivery point code.”

The rest of *Fleckenstein* is equally silent with regard to sequencing of items for delivery. Rather than using the item code to sequence or even distinguish a location, *Fleckenstein* instead appears to use a delivery notice code to specify a primary location (*Fleckenstein* at ¶ [0008]) and a unique alternate delivery code to specify a second (and different) location for delivery when the recipient is unavailable at the primary delivery location. *Fleckenstein* at ¶ [0013]. According to *Fleckenstein*, a unique “item code” is assigned for “each of the plurality of items” associated with the “delivery notice code” (*Fleckenstein* at ¶ [0008]), leaving no reason whatsoever for the item code to also specify the delivery location.

Because the item code in *Fleckenstein* does not pertain to the delivery location, the fact that the item code is never changed is not suggestive in any way that “the alternate delivery point code contains the same number of digits as the normal delivery point code.” The other cited references do not cure this shortcoming.

C. No *prima facie* case of obviousness

In view of at least these shortcomings of *Shaffer*, *Wilson*, and *Fleckenstein*, the Office Action does not properly determine the scope and content of the prior art or explain why the differences between the cited references and amended claims 1, 16, and 31 would have been obvious to one of ordinary skill in the art. Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claims 1, 16, and 31, and the rejections under 35 U.S.C. § 103(a) must be withdrawn. For the same reasons, claims 2-4, 6-7, 9-15, 17-19, 21-22, 24-30, 32-34, 36-37, and 39-45¹ are also allowable at least due to their dependence from independent claims 1, 16, and 31.

Conclusion²

In view of the foregoing remarks, Applicants submit that the pending claims, as amended, are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request that the Examiner reconsider and withdraw the rejections of the pending claims and pass this application to issue.

¹ Accordingly, dependent claims 9-11, 24-26, 29-30, 32-34, and 36-41 do not depend on a properly rejected base claim, and Applicants submit that the objection to these claims is overcome for at least these reasons.

² It is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants believe that they are entitled to have the

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

/ Brannon McKay /

Dated: January 27, 2011

By: _____
Brannon C. McKay
Reg. No. 57,491
(404) 653-6410

claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.